

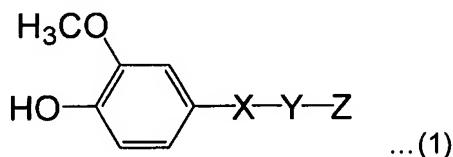
ELECTION/RESPONSE

Provisional Election of Species Pursuant to 37 CFR §1.142

Applicants elect the following single disclosed species, as required by the Examiner:

A composition comprising:

a 2-methoxyphenol derivative having formula (1) below:



where X is an unsubstituted C₁-C₃₀ alkylene;

Y is -O-;

Z is selected from the group having the formula of

-(CH₂CH₂O)_a(CH₂CH(CH₃)O)_b-(CH₂CH₂O)_c-H where a, b, and c are less than 10;

a functional aqueous medium that is water; and

a functional colorant that is a carbon black pigment.

The terminology "an unsubstituted C₁-C₃₀ alkylene group" refers to a straight or branched bivalent aliphatic hydrocarbon group having from 1 to 30 carbon atoms, and all combinations and subcombinations of ranges therein. The alkylene group may be straight, branched or cyclic. Exemplary alkylene groups include, but are not limited to, for example, methylene (-CH₂-), ethylene (-CH₂CH₂-) and propylene (-CH₂)₃-).

Claim 2 has been amended to recite the above elected species. Claims 3, 5, 6-19, 21, 24, and 27 read on the species of amended claim 2. It should be noted that claim 25 was cancelled in the previous Response. Claim 1 is withdrawn.

However, as is noted below, it is respectfully submitted that, as discussed with the Examiner's Supervisor Vasu Jagannathan on February 22, 2006 since the Examiner was not available, a specific colorant is not patentably distinct and a specific aqueous medium is also not patentably distinct. It is known to those skilled in the art that specific dyes and pigments provide specific colors, and thus are functional (see below). Similarly, a specific aqueous medium provides liquidity, a functional characteristic of an ink, and hence is submitted not to be

patentably distinct. Hence, although a specific colorant and a specific aqueous medium have been elected as required by the Examiner, Applicants respectfully request the withdrawal of the requirement of the election of a specific aqueous medium and the requirement of the election of a specific colorant (see further arguments below).

It is respectfully submitted that “a specific color” itself is not a functional characteristic. In Valu Engineering, Inc. v. Rexnord Corp., 61 USPQ2d, 1426 (CAFC, January 23, 2002), the court defined the meaning of “functionality”:

...[t]he Court noted, in describing the proceedings below where functionality had been at issue, that “[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” 456 U.S. at 850 n.10 (214 USPQ 1) (1982).

Hence, although a colorant is included in the composition, since each specific colorant determines a specific color, it would deny the functionality of the colorant if a recitation of a specific colorant were to be required in the independent claim of the species. Hence, the colorant is submitted to provide a functional product feature (color), and the colorant is functional. That is, as is clear to one skilled in the art, the composition includes a functional additive, a functional aqueous medium and a colorant that is functional. Hence, in amended claim 2, a functional colorant is essential to the use or purpose of the article and would not substantially affect the cost or quality of the article because a colorant provides color to the composition. However, a specific colorant would not be functional in that its single color would not be essential to the use or purpose of the article since any specific colorant for any selected color could be utilized. Hence, claim 2 has been amended to recite “a functional colorant” for clarity. The functionality of the colorant is further supported by page 9, paragraphs [0031]-[0033], of the specification. Also, it should be noted that to require a specific colorant (i.e., a specific color) to be recited in independent claim 2 would appear to necessitate that divisional applications be filed for every color of the ink in which the composition is utilized, which is respectfully submitted by Applicants as being an undue burden on the Applicants. Hence, Applicants respectfully request that the requirement for reciting a specific colorant be withdrawn.

Hence, it is respectfully submitted that it is unnecessary to specify a specific colorant in the elected species, and that the functional colorant provides a single disclosed species.

Although an aqueous medium is included in the composition, since each specific aqueous medium is water or water diluted by an organic solvent, it would deny the functionality

of the aqueous medium if a recitation of a specific aqueous medium were to be required in the independent claim of the species. Hence, the aqueous medium is submitted to provide a functional product feature (liquidity), and the aqueous medium is functional. That is, as is clear to one skilled in the art, the composition includes a functional additive, a functional colorant, and an aqueous medium that is functional. Hence, in amended claim 2, a functional aqueous medium is essential to the use or purpose of the article because a functional aqueous medium provides a liquid solvent for the composition so that the composition may be utilized as an ink. However, a specific aqueous medium would not be functional in that if (1) water alone were utilized or (2) water diluted by an organic solvent were utilized, either individual use of (1) or (2) would not be essential to the use or purpose of the article since either functional aqueous medium (1) or (2) would be effective if used alone, and although the use of one selected from the combination of (1) and (2) would be essential, neither one individually would be essential because the other could be utilized. Hence, claim 2 has been amended to recite "a functional aqueous medium" for clarity. The functionality of the aqueous medium is further supported by page 8, paragraph [0026], of the specification. Also, it should be noted that to require a specific aqueous medium (i.e., either water or water diluted with an organic solvent) to be recited in independent claim 2 would appear to necessitate that divisional applications be filed, which is respectfully submitted by Applicants as being an undue burden on the Applicants. Hence, Applicants respectfully request that the requirement for reciting a specific aqueous medium be withdrawn.

Hence, it is respectfully submitted that it is unnecessary to specify a specific aqueous medium in the elected species, and that the functional aqueous medium provides a single disclosed species.

It is respectfully submitted that a single species is now disclosed substantially in accordance with the Examiner's instructions.

Applicants reserve the right to further prosecute without prejudice the non-elected Species, and the claims readable thereon.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

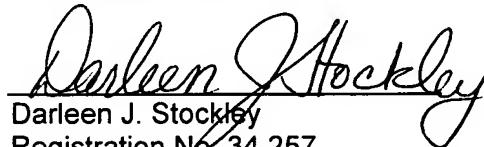
Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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By:


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